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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/999,308	12/29/97	FUJINO	N FUJ014691

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EMPIRE STATE BUILDING
60TH FLOOR
NEW YORK NY 10118-0110

LM02/0915

EXAMINER

ENG, G

ART UNIT	PAPER NUMBER
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2743

DATE MAILED:

09/15/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/999,308

Applicant(s)
Fujino et al.

Examiner
George Eng

Group Art Unit
2743

☒ Responsive to communication(s) filed on Jun 30, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-6 and 9-14 is/are rejected.

☒ Claim(s) 7, 8, and 15 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

1. This Office action is in respond to the amendment filed 6/30/1999 (paper # 5).

Claim Rejections - 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 1-6 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldman et al. (US PAT. 4,995,074 hereinafter Goldman) in view of Garland et al. (US PAT. 5,812,656 hereinafter Garland).

Regarding claim 1, Goldman discloses a communication system as shown in figure 1 comprising a server (i.e., a host computer 16), a terminal 14 for communicating data with the server, a communication network 12, and an interface (i.e., 28) for disconnecting a line being used for data communication without issuing any disconnection notifications of the terminal when a third party other than the server is being voice communicated during a data communication between the terminal and the server (col. 4 lines 31-61 and col. 5 lines 4-11). Goldman differs from the claimed invention in not specifically teaching the interface in respond to a specified data from the server and the terminal for disconnecting a line being used for data communication. However, Garland teaches to hold a data call by entering a predetermined code or other distinctive code (col. 7 lines 34-39). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the communication system of Goldman as taught by Garland because it improves the communication of Goldman so that the communication system is not only able to receive an incoming call from a third party during data communication but also to originate a call to a third party during data communication.

Regarding claim 2, Garland discloses the calling unit obtaining a number of the third party in order to set up a call (col. 3 lines 60-62).

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Regarding claims 3-4, Goldman teaches the server comprising a telephone switch means and an interface (i.e., 34) for temporarily disconnecting a line between the server and the terminal when a voice communication to the third party is issued (col. 4 line 62 through col. 5 line 11).

Regarding claim 5, Garland discloses means for disconnecting the line when a request for voice communication with the third party (col. 8 lines 51-62).

Regarding claim 6, Goldman teaches the interface comprising a first means for managing communication status (col. 5 line 49 through col. 6 line 2).

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claims 11-12, the limitations of the claims are rejected as the same reasons set forth in claims 3-4.

Regarding claim 13, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 6.

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Allowable Subject Matter

4. Claims 7-8 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

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7. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

(703) 305-9508 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

GEORGE ENG

September 8, 1999


CURTIS A. KUNTZ
SUPERVISORY PATENT EXAMINER
GROUP 2700